

## REMARKS

Claims 30-39, 41-50, 56, 57, 60-64, 107 and 108 are pending in the present application. Claims 111-120 have been added in the present amendment and are supported by the specification. No new matter has been added. Claim 40 has been canceled without prejudice. In summary of the outstanding Office Action, claims 1-29, 51-55, 58, 59, 65-106 and 109-110 stand objected to for informalities. Claims 30, 31, 34-38, 40, 43 and 50 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 5,619,247 (Russo). Claims 32, 33, 39, 41, 42, 44-49, 56, 57, 60-64, 107, and 108 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Russo in view of one or more of the following: U.S. Patent No. 6,177,931 (Alexander), U.S. Patent No. 6,522,769 (Rhoads), U.S. Patent No. 5,963,217 (Grayson), U.S. Patent No. 5,734,720 (Salganicoff), U.S. Patent No. 6,804,825 (White), and U.S. Patent Application Publication No. 2002/0056112 (Dureau).

Reconsideration of the outstanding objections and rejections to the claims is respectfully requested in view of the present amendments and following remarks.

### Objections Due to Informalities

Claims 1-29, 51-55, 58, 59, 65-106 and 109-110 stand objected to for informalities. The present amendment addresses these issues by correcting the alleged informalities. Therefore, withdrawal of the objections is earnestly solicited

### Rejections under 35 USC § 102(e)

Claims 30, 31, 34-38, 40, 43 and 50 stand rejected under 35 U.S.C. § 102(e) as allegedly anticipated by U.S. Patent No. 5,619,247 (Russo).

Regarding claim 40, it has been canceled without prejudice.

Regarding claim 30, the Office Action states that Russo teaches "permitting the user to preselect and record a movie." However, the Office Action does not address the language of claim 30 as amended which states "providing a mechanism for the viewer to select desired digital data content from the digital data content received by the viewer." In Russo, the user selects

programs to be recorded at a later time from transmitted future schedule information (Co. 9, lines 38-45), not from the actual transmitted data content received that is to be stored once selected. In Russo, the actual data content for storage is not transmitted until after the user selects the content for future storage from the schedule (Col. 9, lines 46-51). This is opposed to claim 30, wherein the data content for storage is transmitted to the user before selection. Claim 30 refers to the "data content received" as that which has already been transmitted to the user for selection (see the first act of claim 30). Thus, for the reasons above and others, Applicants submit that all the limitations of claim 30 are not taught or suggested by Russo.

Regarding claims 31, 34-38, 43 and 50 they either depend directly or indirectly from claim 30, or were rejected for the same reasons as claim 30 with respect to elements they allegedly share in common. Thus Applicants submit that all the limitations of claims 31, 34-38, 43 and 50 are not taught or suggested by Russo for the same reasons presented above. Therefore, withdrawal of the rejections under 35 U.S.C. § 102(e) for claims 30, 31, 34-38, 43 and 50 is earnestly solicited.

**Rejections under 35 USC § 103(a)**

Claims 32, 33, 39, 41, 42, 44-49, 56, 57, 60-64, 107, and 108 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Russo in view of one or more of the following: U.S. Patent No. 6,177,931 (Alexander), U.S. Patent No. 6,522,769 (Rhoads), U.S. Patent No. 5,963,217 (Grayson), U.S. Patent No. 5,734,720 (Salganicoff), U.S. Patent No. 6,804,825 (White), and U.S. Patent Application Publication No. 2002/0056112 (Dureau)..

Claims 32, 33, 39, 41, 42, 44-49, 56, 57, 60-64, 107, and 108 either depend directly or directly from claim 30, or were rejected for the same reasons as claim 30 with respect to elements they allegedly share in common. Thus Applicants submit that all the limitations of claims 32, 33, 39, 41, 42, 44-49, 56, 57, 60-64, 107, and 108 are not taught or suggested by Russo for the same reasons presented above. Therefore, Applicants respectfully submit that all the limitations of claims 32, 33, 39, 41, 42, 44-49, 56, 57, 60-64, 107, and 108 are not taught or

suggested by Russo, Alexander, Rhoads, Grayson, Salganicoff, White, Dureau or any combination thereof, for the same reasons presented above for claim 30.

“To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” MPEP § 2142. Since all the limitations of claims 32, 33, 39, 41, 42, 44-49, 56, 57, 60-64, 107, and 108 are not taught or suggested by Russo, Alexander, Rhoads, Grayson, Salganicoff, White, Dureau or any combination thereof, for the reasons presented above, withdrawal of the rejections under 35 U.S.C. § 103(a) for claims 32, 33, 39, 41, 42, 44-49, 56, 57, 60-64, 107, and 108 is earnestly solicited.

Applicants would also like to note that the present application is related to U.S. Patent Application Serial No. 09/781,680 and Application Serial No. 09/781,679, both filed on February 12, 2001, and U.S. Patent Application Serial No. 09/737,826, filed on October 21, 2004. The examiners in those cases have collectively cited U.S. Patent No. 5,619,247 (Russo), International Publication No. WO 01/54410 A2 (Braitberg), U.S. Patent Application Publication No. 2004/0083492 (Goode et al.), U.S. Patent No. 6,438,751 (Voyticky), Patent Application Publication No. 2004/0054630 A1 (Gitner et al.), U.S. Patent Application Publication No. 2004/0054630 (Yuen et al.), U.S. Patent Application Publication No. 2002/0100043 (Lowther), U.S. Patent No. 6,148,428 (Welch), U.S. Patent No. 6,069,868 (Kashiwagi), U.S. Patent No. 5,862,260 (Rhoads), and U.S. Patent No. 4,794,465, (Luyt).

### **CONCLUSION**

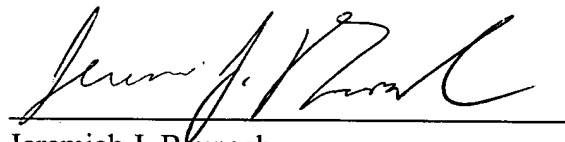
Applicants believe that the present reply is responsive to each point raised by the Examiner in the Office Action and Applicants submit that claims 30-39, 41-50, 56, 57, 60-64, 107, 108 and 111-120 of the application are in condition for allowance. Favorable consideration and passage to issue of the application at the Examiner's earliest convenience is earnestly solicited. However, should the Examiner find the claims as presented herein to not be allowable for any reason, Applicants' undersigned representative earnestly requests a telephone conference at (206) 332-1392 with both the Examiner and the Examiner's Supervisor to discuss the basis for

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the Examiner's continued rejection in light of the Applicant's arguments presented herein. Specifically, should the Examiner find the claims presented herein not to be allowable, Applicant's undersigned representative would respectfully request the Examiner to point Applicants to the column and line numbers in Russo where a viewer selects desired digital data content from the digital data content actually received by the viewer, as opposed to selecting from a schedule of future shows received by the viewer. Likewise, should the Examiner have any questions, comments, or suggestions that would expedite the prosecution of the present case to allowance, Applicants' undersigned representative would very much appreciate a telephone conference to discuss these issues.

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